

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GP 2761

In re Application of: Jay S. Walker et al.

For: METHOD AND APPARATUS FOR
FACILITATING ELECTRONIC
COMMERCE THROUGH PROVIDING
CROSS-BENEFITS DURING A
TRANSACTION

Serial No.: 09/219,267

Filing Date: December 23, 1998

Assistant Commissioner for Patents
Washington, D.C. 20231



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Examiner: Not Yet Assigned

Group Art Unit: 2761

Docket No.: WD2-98-109

#5
J. Carlson
7-26 99

TRANSMITTAL LETTER

Sir:

Applicants hereby submit the following documents for the above-identified patent application:

1. Information Disclosure Statement;
2. Form PTO-1449;
3. Copy of seventeen (77) references cited therein; and
4. Postcard.

The Commissioner is hereby authorized to charge \$ 0.00 to Deposit Account No. 50-0271 for the fees required for the enclosed Information Disclosure Statement. The Commissioner is further authorized to charge any further required fees, or to credit any overpayment, to Deposit Account No. 50-0271. A duplicate copy of this authorization is attached for such purpose.

Respectfully submitted,

May 17, 1999

Date

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Certificate of Mailing

I hereby certify that this correspondence is being sent via first class mail in an envelope with sufficient postage addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on May , 1999.

Sylvia Gonzalez
Typed Name of Person Making
Deposit

Signature

05/17/99
Date

- A. U.S. Patent No. 4,491,725 entitled "MEDICAL INSURANCE VERIFICATION AND PROCESSING SYSTEM" issued to Lawrence E. Pritchard on January 1, 1985.
- B. U.S. Patent No. 4,667,292 entitled "MEDICAL REIMBURSEMENT COMPUTER SYSTEM" issued to William C. Mohlenbrock et al. on May 19, 1997.
- C. U.S. Patent No. 4,750,119 entitled "PURCHASING SYSTEM WITH REMOTE PAYMENT FEATURE" issued to Jeffery M. Cohen et al. on June 7, 1988.
- D. U.S. Patent No. 4,982,346 entitled "MALL PROMOTION NETWORK APPARATUS AND METHOD" issued to Kenneth P. Girourd et al. on January 1, 1991.
- E. U.S. Patent No. RE.34,380 entitled "METHOD AND APPARATUS FOR APPLYING MESSAGES IN A TELECOMMUNICATIONS NETWORK" issued to Neil F. Sleeve on September 14, 1993.
- F. U.S. Patent No. 5,287,268 entitled "CENTRALIZED CONSUMER CASH VALUE ACCUMULATION SYSTEM FOR MULTIPLE MERCHANTS" issued to Patrick D. McCarthy on February 15, 1994.
- G. U.S. Patent No. 5,319,542 entitled "SYSTEM FOR ORDERING ITEMS USING AN ELECTRIC CATALOGUE" issued to John E. King, Jr., et al. on June 7, 1994.
- H. U.S. Patent No. 5,333,186 entitled "TELECOMMUNICATION CALL BILLING METHOD AND APPARATUS" issued to Shiv K. Gupta on July 26, 1994.
- I. U.S. Patent No. 5,523,794 entitled "METHOD AND APPARATUS FOR PORTABLE STORAGE AND USE OF DATA TRANSMITTED BY TELEVISION SIGNAL" issued to Roy J. Mankovitz on June 4, 1996.
- J. U.S. Patent No. 5,612,868 entitled "METHOD AND APPARATUS FOR DISPENSING DISCOUNT COUPONS" issued to George W. Off et al. on March 18, 1997.
- K. U.S. Patent No. 5,619,558 entitled "ATM SEGMENT OF ONE MARKETING METHOD" issued to Elizabeth A. Jheeta on April 8, 1997.

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- L. EP 809202 Patent entitled "METHOD AND SYSTEM FOR REGULATING DISCOUNTS ON MERCHANDISE DISTRIBUTED THROUGH NETWORKED COMPUTER SYSTEMS" issued to Jakob Nielson on November 26, 1997.
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- V. U.S. Patent No. 5,774,869 entitled "METHOD FOR PROVIDING SPONSOR PAID INTERNET ACCESS AND SIMULTANEOUS SPONSOR PROMOTION" issued to Adrian Toader on June 30, 1998.
- W. U.S. Patent No. 5,794,221 entitled "INTERNET BILLING METHOD" issued to Andrew Egendorf on August 11, 1998.
- X. U.S. Patent No. 5,794,210 entitled "ATTENTION BROKERAGE" issued to August 11, 1998.
- Y. U.S. Patent No. 5,806,044 entitled "SYSTEM AND METHOD FOR DISTRIBUTING COUPONS THROUGH A SYSTEM OF COMPUTER NETWORKS" issued to Ken R. Powell on September 8, 1998.
- Z. U.S. Patent No. 5,806,045 entitled "METHOD AND SYSTEM FOR ALLOCATING AND REDEEMING INCENTIVE CREDITS BETWEEN A PORTABLE DEVICE AND A BASE DEVICE" issued to James E. Biorge et al. on September 8, 1998.
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- CC. U.S. Patent No. 5,819,092 entitled "ONLINE SERVICE DEVELOPMENT TOOL WITH FEE SETTING CAPABILITIES" issued to Charles H. Ferguson et al. on October 6, 1998.
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- LL. Wessel, Harry "REWARDING EXPERIENCE?; CREDIT CARDS OFFERING BONUSES NOT FOR EVERYONE", Chicago Tribune, November 4, 1996.
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- SS. Gilligan, Gregory J. "CREDIT CARDS FROM RETAIL STORES A MIXED BLESSING FOR SHOPPERS", The Richmond Times Dispatch, July 20, 1997.

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- EEE. "SNET CELLULAR VALUE PLANS", Brochure, June 12, 1998.
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XXX. "AT SPORTS SUPERSTORE ONLINE, SHOPPERS GET MORE FOR THEIR MONEY; 10,000 REASONS TO SHOP AT SPORTS SUPERSTORE ONLINE", Business Wire, December 4, 1998.

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1. ☐ Any copy of the items listed above and on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior ☐ Continuation, ☐ Divisional or ☐ Continuation in part application filed under 37 C.F.R. §§ 1.53 or 1.60, U.S. Serial No. _____, filed _____.
2. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a European Search Report from a counterpart European application is enclosed. Such items are marked as reference letter(s): _____.
3. ☐ For each of the following items listed above and on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application. Such items are marked as reference letter(s): _____.
4. ☒ In addition to the citations listed above, applicants respectfully direct the Examiner's attention to the following U.S. patent applications, which are commonly assigned to the assignee of the instant application, and which may be deemed pertinent to the instant application:

<u>Serial No.</u>	<u>Inventors</u>	<u>Filing Date</u>	<u>Group Art Unit</u>	<u>Examiner's Init.</u>
08/943,483	Walker et al.	10/03/97	3642	
08/994,426	Walker et al.	12/19/97	2761	
09/100,684	Tedesco et al.	06/19/98	2761	
09/166,367	Walker et al.	10/05/98	2761	
09/166,405	Walker et al.	10/05/98	2761	
09/205,663	Walker et al.	12/04/98	2761	

The Examiner is respectfully requested to fully consider and independently ascertain the teachings and relevance of those applications with respect to the instant application. These applications have not been listed on the accompanying Form PTO-1449 in order to preserve their secrecy during the course of their prosecution.

5. ☐ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:

- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491.
 - ☒ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office Action on the merits.
6. ☐ No fee is believed to be due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. 1.97(c), after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c) after the period specified in paragraph 5 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action). The fee due under 37 C.F.R. §1.17(p) is to be paid as set forth in paragraph 11 below.
8. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in accordance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a Notice of Allowance, but before the payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 10 below; and
 - b. the attached petition requesting consideration of this Information Disclosure Statement; and
 - c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 11 below.
9. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:
- ☐ 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition to Withdraw Application from Issue;
 - ☐ 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and

is accompanied by the attached Petition to Withdraw Application from Issue.

- ☐ The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 11 below.

10. ☐ I hereby certify:

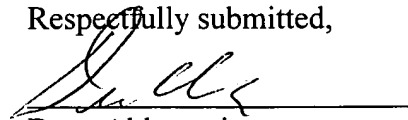
- ☐ that each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. A copy of such communication is enclosed.
- ☐ that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

11. ☐ Please accept payment of the fees due as indicated below:

- ☐ A check in the amount of \$240.00 is enclosed in payment of the fee due under 37 C.F.R. 1.17(p).
- ☐ The Commissioner is hereby authorized to charge \$240.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(p). A duplicate copy of this sheet is attached for such purpose
- ☐ A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).
- ☐ The Commissioner is authorized to charge \$130.00 to Deposit Account No. 50-0271 in payment of the fee due under 37 C.F.R. §1.17(i)(1). A duplicate copy of this sheet is attached.

12. [X] The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 50-0271. A copy of this authorization is attached.

Respectfully submitted,



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